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PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY
(PCT Rule 43bis.1)

Date of mailing

(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/GB2004/003281

International filing date (day/month/year)
28.07.2004

Priority date (day/month/year)
31.07.2003

International Patent Classification (IPC) or both national classification and IPC
G06K9/22

Applicant
TOBIN, Jennefer Margaret

1 This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

566564
International application No.
PCT/GB2004/003281

IAP20 Rec'd PCT/TO 31 JAN 2006

Box No. I Basis of the opinion

With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
- a. type of material:
- ☐ a sequence listing
- ☐ table(s) related to the sequence listing
- b. format of material:
- ☐ in written format
- ☐ in computer readable form
- c. time of filing/furnishing:
- ☐ contained in the international application as filed.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority for the purposes of search
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/GB2004/003281

Box No. II Priority

☒ The following document has not been furnished

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)

Yes: Claims

No: Claims

Inventive step (IS)

Yes: Claims

No: Claims 1-13

Industrial applicability (IA)

Yes: Claims

No: Claims

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/GB2004/003281

IAP20 Rec'd CTG:WFO 31 JAN 2006

The following documents are referred to in this communication:

- D1: WO 96/27171 A (UNITED PARCEL SERVICE INC) 6 September 1996 (1996-09-06)
- D2: FR-A-2 745 926 (LE TESSIER DIDIER) 12 September 1997 (1997-09-12)
- D3: WO 94/18663 A (BARON EHUD ; WOLFE EDWARD A (IL); PRISHVIN ALEXANDER (IL)) 18 August 1994 (1994-08-18)
- D4: WO 03/093771 A (TOBIN JENNEFER MARGARET) 13 November 2003 (2003-11-13)

Re Item II.

- 1 A copy of the priority document claimed by the present application was not available at the time of the writing of this opinion. Therefore, it was assumed that the claimed priority is valid. Should the priority document be found invalid, document D4 (on the name of the applicant and having the same inventor), published after the claimed priority but before the date of filing of the present application could become relevant prior art for issues concerning novelty (see Art. 4B, 4C(4) of the Paris Convention, Art. 33(2) PCT in combination with Rule 64 PCT, Section 17.26 PCT Guidelines).

Re Item V.

2 INDEPENDENT CLAIM 1

- 2.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 does not involve an inventive step in the sense of Article 33(3) PCT.

With the provisions of clarity remarks at point 5 below, document D1 discloses (the references in parenthesis applying to this document) a personal digital assistant (PDA) comprising a stylus ("digital pen") and provided with means for recording user input and uploading the input data to a computer (abstract, p.6, l.1 - p.7, l.25, Fig. 1-5). Said stylus is provided with a wand-mounted symbol reader which can read tags (such as bar codes) attached to various objects for the purpose of their identification (p.13, l. 13-18).

The subject-matter of claim 1 differs from the teachings of document D1 in that
(a) the pen is provided with means for recording penstroke data,
(b) the location at which penstroke data is to be recorded seems of particular relevance since:

- "the identity tag is fixed at a location at which penstroke data are to be recorded" and
 - "the identity of each tag is stored in association with its location", and
- (c) penstroke data is "associated" with the object identified by its identity tag.

It is considered as well-known that an electronic writing device (stylus) can be provided with the capability of recording penstrokes, especially in devices with touch-screens (e.g. PDA, tablets), or when used in conjunction with "digital paper" or as a stand-alone device (see, e.g. D3). In such cases, recording penstrokes with the purpose of data input is considered as functionally equivalent with touching areas which define keys on the display of a PDA, as disclosed by D1. Moreover, having regard to the description, it would seem that no special technical effect (such as, for instance, identifying the user by performing handwritten recognition) is achieved by recording penstroke data instead of keyboard input, fact which makes the two modalities of data input functionally equivalent.

Therefore, having regard to the teachings of D1, the feature of providing means for recording penstroke data is considered as not inventive.

Concerning 2.2(b), it is considered as well-known that other types of information, such as the identity of the person performing a task of inspection/maintenance, the location of the object at which the task has to be performed, the time interval in which the task takes place are of particular relevance when performing such inspection/maintenance activities (see e.g. D2, p.5, l. 4-14). Therefore, other features of claim 1, such as the fact that the identity tag is stored in combination with its location and that the tag is fixed at the location in which maintenance takes place are considered as mere design choices for the said task. Such choices would be dictated, for instance, when certain procedural steps concerning a protocol of inspection/maintenance have to be followed.

Concerning 2.2(c), it is noted that D1 discloses that a database comprising maintenance schedules and records of activities for each object is maintained

using such a device (p. 17, l. 5-28). These features implicitly state that the identity of each object is considered to be known and that the input data refers to (is stored in combination with) that particular object.

- 2.4 For these considerations, the subject-matter of claim 1 lacks inventive step, contrary to the requirements of Art. 33(3) PCT.

3 DEPENDENT CLAIMS 2-9

- 3.1 Dependent claims 2-9 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step (Article (3) PCT).

Claim 2: see D1, p.7, 1-14

Claim 3: with the clarity provision of point 5(g) below, it would appear that taking into account the sequence in which certain events occur in time during a task of maintenance/ inspection is common practice, e.g. D1, p.15, l.27-32, D2, p. 8, l.19-23, p.10, l. 3-11.

Claim 4: storing the identity of the user/person performing the task is well-known, see D1,p.8, l.31 - p.9, l.3, also D2, p. 7, l.1-5.

Claim 5: providing indicating means, see the touch-screen display of the PDA disclosed in D1.

Claim 6: this claim refers to a maximum amount of time which may elapse between reading the identification tag and/or the personal identification tag and recording the penstroke data (it would appear that this claim clarifies what the "specified conditions" are).

Generally, it is considered as common practice in personal authentication to set a relatively short period in which the identification of a person is considered as valid. Setting such a "time window" for the concerned person to proceed with the task at hand is specifically intended to prevent a second person (imposter) to misuse the successful authentication of the first. A well-known instance of such practice is encountered, for example, when passing through a door providing access to a

restricted area. In this case, by means of some visual indication (red, green lights) it is shown to the concerned person that the access is valid only for a limited time, usually in the order of seconds. Therefore, the above feature is considered as not inventive.

Claim 7: storing the date and time when the maintenance/inspection task took place, see D1, p.9, l.4-10.

Claim 8: identifying the tag by physical contact is regarded as a mere operation design choice, therefore not inventive.

Claim 9: providing the digital pen with a barcode reader, see D1, p. 7, -14.

4 CLAIMS 10-13

Independent claim 10, together with the dependent claim 11-13 concern steps of the method corresponding to the apparatus claimed in claim 1. Therefore, the considerations mentioned at points 2 and 3 above apply *mutatis mutandis* to these claims.

Re Item VII.

5 The following clarity issues (Art. 6 PCT) are observed

(a) Claim 1 as a whole is unclear since some of the features refer to the components of an apparatus, "*means of recording penstroke data*", "*means of uploading the penstroke data to a computer*", while other features concern a method claim, "characterised in that the pen *is used* in association with a plurality of identity tags" [.]

(b) Claim 1 in its entirety is unclear since it defines the features of the "digital pen" in relation with features of another entity, namely an "identity tag". From the wording of the claim, a skilled person would have difficulty in inferring the scope for which protection is being sought (is the claim directed only to the "digital pen" or does it concern the pen in relation with the "identity tags"? Which features of an identity tag would make it fall into the envisaged scope of protection?).

(c) The preamble of claim 1 reads that a "digital pen" is an apparatus which comprises a "writing instrument". It is, however, generally accepted that a pen *is in itself* a writing instrument. Therefore, in this context, the word "comprising" is misleading.

(d) From the wording of claim 1, the wording "tag being fixed at a location at which penstroke data are to be recorded" is misleading since it might be understood that the said location refers to a region which is part of the "digital paper" on which the pen is supposed to write.

(e) In claim 1, the wording "associating the identity read from each said tag with the penstroke data recorded at its location" is vague since it cannot be inferred what such an association would consist of.

(f) Most of the features of claim 1 are claimed by the wording "in association", "associating", etc. This wording is ambiguous since, in most of the cases, it is difficult to determine what would an "association" consist of.

(g) The term "specified conditions" used in claims 3-5 is ambiguous, with no clear technical meaning. In the light of the description, it would appear that said term refers to the occurrence, sometimes having a predetermined sequencing in time, of certain events during the procedural steps to be followed in a process of inspection/maintenance.